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THOMTE, MAZOUR & NIEBERGALL, L.L.C. 2120 S. 72ND STREET, SUITE 1111 OMAHA, NE 68124				
			EXAMINER BROWN, MICHAEL A	
			ART UNIT 3764	PAPER NUMBER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/827,032
Filing Date: April 19, 2004
Appellant(s): SLOAN, STEWART E.

MAILED
JAN 30 2006
Group 3700

Dennis L. Thomte
For Appellant

EXAMINER'S ANSWER

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief. This is in response to the appeal brief filed November 7, 2005 appealing from the Office action mailed August 23, 2005.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

D356,354	Killion	03-1995
D373,402	Williamson	09-1996
4,867,451	Mitchell	09-1989
5,597,159	Haygood	01-1997
6,062,993	Rodriguez	05-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claims 2-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification doesn't provide as antecedent basis for the V-shaped handle. Note: The 112 rejection pertaining to the claims 2-15 not being combination claims has been removed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3-4, 6, 8, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Haygood.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haygood in view of Mitchell.

Claims 7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haygood in view of Rodriguez.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haygood in view of Mitchell, along with Killion.

(10) Response to Argument

Appellant argues that it isn't improper to recite claims 2-15 as combination claims. The examiner concurs. Appellant argues that original claim 11 described the hand-gripping portion as being generally V-shaped and that since original claim 11 is a part of the specification, the V-shape doesn't have to be recited in the original specification. Although the claims and the specification are a part of the original disclosure, any claim language recited in the claims must be recited in the specification.

The first issue in this Examiner's Answer is: Whether claims 3-4, 6, 8, 11 and 15 are patentable over Haygood pursuant to 35 U.S.C. section 102 (b). Appellant argues that the handle (4) of Haygood is not elongated. Thus, Haygood can't anticipate claims 3-4, 6, 8, 11 and 15. However, as set forth in the final rejection the handle was interpreted as two integral parts (4) and 12). Clearly the portion (4) of the handle is elongated. However, the other portion of the handle (12) extends the handle (which was interpreted as elongating the handle). The two elements (4, 12) were interpreted

as the handle because both elements are used to hold the ball in place just as the handle is used to hold the ball in place in the present invention.

The second issue in this Examiner's Answer is: Whether claims 2 and 5 are patentable over Haygood in view of Mitchell. Appellant argues that Mitchell is non-analogous art and that it relates to a toy, while Appellant's invention relates to a massage device. The examiner used Haygood to set forth a device that disclosed a handle having first and second ends and ball attached to the second end. Mitchell was used as a modifier to provide a teaching of making the handle of a flexible material that is plastic. Clearly, Mitchell is analogous to Haygood because they are structurally and functionally equivalent. Also both devices are capable of performing the same massaging effect as disclosed by the Appellant.

The third issue in this Examiner's Answer is: Whether claims 7 and 9-10 are patentable over Haygood in view of Rodriguez under 35 U.S.C. section 103 (a). Appellant argues that claims 7 and 9-10 are patentable for the reason expressed in support of claim 15 as set forth above. Appellant also argues that Rodriguez relates to non-analogous art. However, Rodriguez was used as a modifier to provide a teaching of placing a tennis ball inside of a net. The purpose for the net was to retain the tennis ball. Thus, the net would retain the ball onto the handle disclosed by Haygood and the tennis ball as taught by Rodriguez could be substituted for the ball disclosed by Haygood because both balls are resilient.

The fourth issues in this Examiner's Answer is: Whether claims 12-14 are patentable over Haygood in view of Mitchell, along with Killion, under 35 U.S.C. section

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103 (a). Appellant argues that the connecting portion in Killion isn't flat. The examiner in interpreting the elongated member in figure 1 as being a flat handle.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Michael Brown


MICHAEL A. BROWN
PRIMARY EXAMINER

Conferees: SPE: Angela Sykes, Primary Examiner: Jerome Donnelly



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